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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,903	11/17/1997	HIROSHI HARUKI	826.1431/JDH	4920

21171 7590 05/29/2002

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**08/971,903**

Applicant(s)  
**Haruki et al**

Examiner  
**James W. Myhre**

Art Unit  
**3622**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on March 13 and 20, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3622

## DETAILED ACTION

### *Response to Amendment*

1. The amendments filed on March 13, 2002 and March 20, 2002 have been considered but is ineffective to overcome the Todd et al (5,867,714) reference.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Todd et al (5,867,714).

Claims 1, 10-13, 16, and 17: Todd discloses a system and method for registering and updating software on a remote computer, comprising:

- a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 13, lines 45-49 and col 14, lines 25-35); and

Art Unit: 3622

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 12, lines 30-65);

c. Extracting information about the new or updated product from one of the remote databases and transmitting the information to the user (col 14, lines 25-35);

Todd further discloses tracking usage data (i.e. number of uses) and using the data to provide targeted suggestions/offers to the user (col 4, lines 31-34 and col 12, lines 30-65)

Claim 2: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 1 above, and further discloses means for the user to request new information about a product from the general management means (col 13, lines 45-49; col 14, lines 1-5; and col 14, lines 26-36).

Claim 3: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 6, lines 50-55 and col 11, lines 43-58).

Claim 4: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses:

a. A personal identification number as part of the registration information (col 13, lines 45-49 and col 14, lines 25-35); and

Art Unit: 3622

b. The type of requested information which is extracted by the general management means and transmitted to the user (col 13, lines 47-49; col 14, lines 1-5; and col 14, lines 26-36).

Claims 5 and 6: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses basing the automatic update of the software on the number of times the application had been accessed. Todd discloses a subscription-based service that analyzes license and maintenance agreements before updating the software (col 12, lines 58-65) and that usage data is being tracked (col 4, lines 31-34 and col 12, lines 30-65). This infers that the subscription is based on the usage of software (i.e. number of uses), probably also tied to a predetermined time period (i.e. 10 uses per month)

Claims 7, 8, 14, 15, and 18-20: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses multiple vendors (remote data sources)(col 13, lines 16-28) updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user (col 12, lines 21-29 and col 12, lines 49-65). Todd discloses that the data is being revised on the remote data source which is part of a network of processing systems (col 13, lines 16-19) and contains a library of revisions (col 14, lines 18-20). Todd's further disclosure that the user may be able to actually purchase the update/new software from the remote data source (col 12, lines 53-57) and that at least one of the remote data servers could be a central data

Art Unit: 3622

source (col 14, lines 41-46), infers that the central data source is being updated by the other remote data sources (i.e. vendor/manufacturer).

*Response to Arguments*

4. Applicant's arguments filed on March 13, 2002 have been fully considered but they are not persuasive.

a. The Applicant argues that Todd "does disclose using pattern tracking data which a manufacturer can use to target its customer base with appropriate advertising", but "does not disclose that information is transmitted from the database to a different vendor (or manufacturer) other than the manufacturer of a particular product" (page 5). The Examiner notes that Todd discloses that numerous users (to include vendors/manufacturers) are connected to the remote data source. As noted by the Applicant above, the manufacturers (or vendors) can receive tracking data and registration information from the remote data source and use the tracking data to target its customer base with appropriate advertisements. However, Todd does not disclose that the manufacturer/vendor can only receive data pertaining to its own products in use by the users. Since the remote data source has registration and tracking information pertaining to all of the hardware and software products on the user's computer system, it is inferred that this information (to include information about competitor's products) is available to all of the manufacturer/vendor using the system. Since there is no mechanism disclosed for sorting the data

Art Unit: 3622

being collected by manufacturer/vendor, such a limitation cannot be read into the disclosure of the Todd invention.

b. The Applicant also argues that the remote data source in Todd receives information, but does not transmit user registration information to other manufacturers. The Examiner notes that as discussed by the Applicant above, Todd discloses that manufacturers can use the information to target its customer base. Since the information is being collected by the remote data source, not the manufacturer, it is inherent that the information is being transferred to the manufacturer. This transfer could be an automatic transfer by the remote data source (probably in response to a predefined contract with the manufacturer) or upon receiving a request for the information from the manufacturer. In either case, the remote data source must transfer the data to the manufacturer before the manufacturer can use it for the targeted advertising as disclosed.

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Art Unit: 3622

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

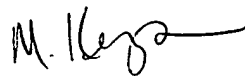
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM

May 21, 2002



MELANIE A. KEMPER  
PRIMARY EXAMINER